

REMARKS

Claims 14-21 are pending following entry of this election. Applicants note that it appears as though our Response dated October 1, 2004 was not entered by the Examiner. As such, the Applicants have prepared this Election based on the status of the claims at the time of the Office action dated July 2, 2004. Claims 1-7 and 22-39 have been withdrawn from consideration and claims 8-13 and 40-43 have been cancelled.

The Examiner has identified in the application the following patentably distinct inventions:

- I. Claims 1-7, drawn to a punch for punching a workpiece including a four-bar linkage and at least two punch elements, classified in class 83, subclass 627;
- II. Claims 8-13, drawn to a punch for punching at least one sheet of paper including a base, a support member having an arcuate portion, and at least one punch mechanism, classified in class 83, subclass 582;
- III. Claims 14-21, drawn to a punch for punching a workpiece including a four-bar linkage including at least four members and a first linkage which operates at least a punch element by imparting a camming action upon the at least one punch element, classified in class 83, subclass 618;
- IV. Claims 22-29, drawn to a punch for punching a workpiece including a four-bar linkage, a base, an actuating portion, and at least four pivots defining therebetween a quadrilateral having at least two opposed, non-parallel sides, classified in class 83, subclass 629;

V. Claims 30-39, drawn to a punch including a support member pivotally coupled to a base, a paper tray, and a drive member pivotally coupled to the base, classified in class 83, subclass 613; and

VI. Claims 40-43, drawn to a method of punching a hole in a sheet of paper, classified in class 83, subclass 13.

The Examiner has required election of one of the inventions for prosecution. In response to the restriction requirement, Applicants elect to prosecute Group III (claims 14-21) with traverse. Applicants withdraw Groups I, IV, and V (claims 1-7 and 22-39), cancel Groups II and VI (claims 8-13 and 40-43), and respectfully request reconsideration of the restriction requirement with respect to Groups I and III-V. Applicants reserve the right to file divisional applications directed to the non-elected claims at a later date.

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is required. *See M.P.E.P. 803*. Applicants respectfully assert that the inventions of Groups I and III-V are not independent or distinct and that examination of the claims of Groups I and III-V can be made without serious additional burden on the Examiner.

The Examiner argues that Groups I-V are related as subcombinations disclosed as usable together in a single combination. A proper restriction as subcombinations disclosed as usable together in a single combination requires that: 1) two or more claimed subcombinations, are disclosed as usable together in a single combination, and 2) it can be shown that the two subcombinations are separately usable. *See MPEP 806.04(d)*. Applicants believe the claims of Groups I and III-V claim the same invention but are of varying scope. As such, the independent claims are by definition separately usable, as are all independent claims of varying scope. However, Applicants have not disclosed that the devices recited in the independent claims are usable together in a single combination. In light of the foregoing, Applicants respectfully submit that the claims of Groups I and III-V are not properly restricted as subcombinations usable together as defined in MPEP §806.05(d).

Furthermore, Applicants believe that continuing the Examination of all of the claims of Groups I and III-V will not result in a serious burden on the Examiner. Any search performed by the Examiner for the elected Group III claims will require a search of art related to the claims of groups I, IV, and V as the claims are directed to the same invention. Specifically, Applicants believe the Examiner will need to search for punches that include four linkages, as claim 14 recites a four-bar linkage. As such, there would be no serious additional burden on the Examiner to examine the claims of Groups I, IV, and V with the claims of Group III.

In light of the foregoing, Applicants respectfully request that the Examiner withdraw the restriction requirement with regard to Groups I and III-V.

The Examiner has further identified the following species of the invention:

Species A – (Figs. 1-9) and support member receiving the workpiece at an upright angle less than 40 degrees from a vertical.

Species B – (Figs. 1-9) and support member receiving the workpiece at an upright angle less than 25 degrees from a vertical.

Species C – (Fig. 10) and support member receiving the workpiece at an upright angle less than 40 degrees from a vertical.

Species D – (Fig. 10) and support member receiving the workpiece at an upright angle less than 25 degrees from a vertical.

Species E – (Figs. 11-14) and support member receiving the workpiece at an upright angle less than 40 degrees from a vertical.

Species F – (Figs. 11-14) and support member receiving the workpiece at an upright angle less than 25 degrees from a vertical.

The Examiner has required election of one of the species for prosecution. Applicants respectfully elect to prosecute Species E shown in Figs. 11-14 with traverse. Elected claims 14-21 are readable on the species of Figs. 11-14. Applicants do not believe the species restriction is proper as related to the claims of elected Group III. Only claims 18, 19, and 20 include limitations that relate to the angle of the workpiece. Claim 18 states that the workpiece is located in an upright punching position. Because no specific angle is given, this claim could read on both Species E and Species F. Similarly, claim 20 recites that the angle is less than about 25 degrees. Thus, claim also reads on both Species E and F as 25 degrees is less than about 40 degrees and is less than about 25 degrees. Therefore, at a minimum claims 18 and 20 are

generic. Claims 14-17 and 21 do not contain any limitation related to the position of the workpiece. As such, these claims could read on both Species E and F. Thus, Species E and F are also generic.

Furthermore, the species identified by the Examiner as Species B, Species D, and Species F seem to fall within the scope of Species A, Species C, and Species E respectively, as an upright angle that is less than 25 degrees is necessarily less than 40 degrees. As such, Applicants believe any claim that reads on Species B, Species D, or Species F also reads on Species A, Species C, or Species E.

In light of the foregoing, Applicants respectfully request that the Examiner withdraw the species restriction. In addition, Applicants note that claims 14-18 and 21 do not contain a limitation as to the specific angle of the workpiece and should not be read as being limited to less than 40 degrees from the upright position.

CONCLUSION

Applicants hereby request withdrawal of the restriction requirements. If the restrictions are upheld, Applicants provisionally elect to prosecute, with traverse, the invention of Group III including claims 14-21 and Species E, which reads on claims 14-21.

Respectfully submitted,



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